

## **REMARKS**

The Final Office Action mailed June 9, 2009, and backdated to June 22, 2009, has been received and carefully reviewed. The following remarks form a full and complete response thereto. No new matter is added by this Amendment. Applicants respectfully request reconsideration of the outstanding rejections, discussed below.

### **Rejections under 35 U.S.C. § 102**

Claims 1-4, 6-8, 10-12, 14, 24-27, 30-32, and 34-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,990,444 to Costin (“Costin”). Applicants respectfully traverse.

#### *Independent Claim 1*

As currently presented, claim 1 is directed toward a document of value that includes a security paper having at least one tangible marking in the form of a relief structure, wherein the relief structure is formed from cotton fibers of the security paper and is produced by a laser.

Costin discloses a method for utilizing a laser to impart graphics onto fabric, leather, and vinyl materials. Costin, Abstract. According to Costin, the method can be used to impart graphic images onto a variety of fabrics made from natural and manmade fibers and blends. Costin, Col. 20, line 58 through Col. 21 line 12. Additionally, Costin teaches that the method can create a “relief look” (i.e., “a very muted design look”) on polyester and polyester/rayon blends “by partially melting a portion of the fibers of the fabric surface.” Costin, Col. 21 lines 13-31.

Costin does not anticipate claim 1 because Costin fails to disclose every limitation recited in claim 1. For example, Costin at least fails to disclose “a security paper” as recited in claim 1. Costin relates to the marking of fabrics and does not disclose or suggest marking any type of paper at all. The June 9 Action appears to argue that element 80 of Costin discloses this feature. However, element 80 is clearly and consistently described as “red polyester,” (Costin at col. 21 ll. 20, 23), not paper. The June 9 Action also cites Col. 20, line 60 as disclosing this feature.

Applicants respectfully disagree. The cited portion of Costin discloses fabrics made from natural and manmade fibers and blends, such as Cotton/Polyester Blends. None of these recited fabrics would be reasonably interpreted as “a security paper” by a person having ordinary skill in the art.

The June 9 Action also appears to argue that Costin discloses a security paper at column 29, lines 1 through 18. Applicants respectfully disagree. The cited passages at best merely disclose cotton fabrics (e.g., clothes, sheets, coats, sweaters, and knit). See Costin at col. 29 l. 60 through col. 30 l. 25 (indicating the types of materials within the scope of Costin’s disclosure). A fabric sheet is not a paper, and person having ordinary skill in the art would not regard a cotton fabric “sheet” as even suggesting a paper with cotton fibers (e.g., cotton vellum paper) as recited in claim 1.

Furthermore, Costin fails to disclose a “relief structure [that] is formed from cotton fibers of the security paper” as recited in claim 1. The June 9 Action cites Col. 21, lines 13-31 as disclosing this feature. Applicants respectfully disagree.

First, the cited passages do not disclose a “relief structure,” but merely a “relief look” comprising simply “a very muted design.” There is no indication anywhere in the cited passage that the method creates any actual relief, merely an appearance of relief. For example, at Col. 21 lines 21-23, the design is described as “a slightly darker red color than the red polyester” that is “at first very hard to visualize.”

The June 9 Action appears to argue that Costin discloses a relief structure at column 29, lines 33 through 59. Applicants respectfully disagree. The cited passages may mention “relief” graphics and “rumpling, crumpling, watering, or crimping a material.” However, “[t]he disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation.” MPEP § 2121.01 (emphasis added). Costin fails to disclose how any of these alleged “relief” structures can be formed. As discussed above, the only “relief” that Costin discloses in any detail is a mere “relief look” that does not include any actual relief structure. Costin does not describe any embodiments related to rumpling, crumpling, watering, or crimping. Therefore the disclosure Costin would not enable a

person having ordinary skill in the art to create any of the mentioned relief structures without undue experimentation.

Second, even the “relief look” is only disclosed vis-à-vis polyester and polyester/rayon blends. Costin, Col. 21 lines 14-16. There is no disclosure or even suggestion that the “relief look,” disclosed in Example III.B, can be imparted onto any of the other fabrics listed in Example III.A. Anticipation requires that “[e]very element of the claimed invention must be literally present, arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). See also Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983) (“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” (emphasis added)). Furthermore, Costin discloses that the “relief look” is likely created by partially melting a portion of the fibers on the fabric surface. Costin, Col. 21 lines 23-25. Applicants submit that cotton does not melt and therefore Costin teaches that the disclosed “relief look” cannot be formed from cotton fibers.

Because Costin at least fails to disclose a security paper and a relief structure [that] is formed from the cotton fibers of the security paper, Costin does not anticipate claim 1. Furthermore, claims 2-4, 6-8, 10-12, 32, and 34 depend from claim 1 and incorporate all of the limitations recited therein and not disclosed by Costin. For at least this reason, Costin fails to anticipate these claims as well. Accordingly, Applicants respectfully submit that the rejection of claim 1 and these dependent claims under 35 U.S.C. § 102(b) should be withdrawn.

#### *Independent Claim 14*

As currently presented, claim 14 is directed toward a security paper having at least one tangible marking in the form of a relief structure formed from cotton fibers of the security paper that is produced by a laser.

Costin does not anticipate claim 14 because Costin fails to disclose every limitation recited in claim 14. For example, as discussed with regard to claim 1, Costin at least fails to disclose “a security paper” and “a relief structure formed from cotton fibers of the security paper” as recited in claim 14. Furthermore, claim 35 depends from claim 14 and incorporates all of the limitations recited therein and not disclosed by Costin. For at least this reason, Costin fails

to anticipate claim 35 as well. Accordingly, Applicants respectfully submit that the rejection of these claims under 35 U.S.C. § 102(b) should be withdrawn.

*Independent Claim 24*

As currently presented, claim 24 is directed toward a method for producing a tangible marking on a document of value, which includes adjusting the inscription parameters of a laser and the composition of a security paper in such a way that the result is a tangible marking in the form of a relief structure that is formed from cotton fibers of the security paper.

Costin does not anticipate claim 24 because Costin fails to disclose every limitation recited in claim 24. For example, as discussed with regard to claim 1, Costin at least fails to disclose “a security paper” and “a relief structure that is formed from cotton fibers of the security paper” as recited in claim 24. Furthermore, claims 25-27, 30-31, and 36 depend from claim 24 and incorporates all of the limitations recited therein and not disclosed by Costin. For at least this reason, Costin fails to anticipate these claims as well. Accordingly, Applicants respectfully submit that the rejection of claim 24 and these dependent claims under 35 U.S.C. § 102(b) should be withdrawn.

**Rejections under 35 U.S.C. § 103**

*Costin*

Claims 5, 9, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Costin. Applicants respectfully traverse.

These claims are patentable over Costin because Costin does not teach or suggest all of the features recited in the claims. For example, as discussed with regard to claim 1, Costin fails to disclose or even suggest at least “a security paper” and a “relief structure [that] is formed from cotton fibers of the security paper” as recited in claim 1 and incorporated into claims 5, 9, and 33 by their dependence on claim 1. For at least this reason, claims 5, 9, and 33 are patentable over Costin. Accordingly, Applicants respectfully submit that the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

*Costin in view of Schell*

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Costin in view of WO 98/03348 of Schell (“Schell”). Applicants respectfully traverse.

Schell discloses a method for protecting a document using a laser etching process. Schell, page 1. According to Schell, at least part of a printed identification mark is repeated at another point on the document by changing the thickness of the document by means of laser etching.

Claim 13 is patentable over Costin and Schell because these references fail to teach or suggest all of the features recited in claim 13. For example, as discussed with regard to claim 1, Costin fails to teach or suggest that a “relief structure is formed from cotton fibers of the security paper” as recited in claim 1 and incorporated into claim 13 by its dependence on claim 1. While Schell may arguably be directed towards documents of value, Schell fails to teach or suggest a relief structure is formed from cotton fibers of a security paper. Nor does the June 9 Action cite any portion of Schell as allegedly disclosing this feature. For at least this reason, claim 13 is patentable over any combination of Costin and Schell. Accordingly, Applicants respectfully submit that the rejection of claim 13 under 35 U.S.C. § 103(a) should be withdrawn.

*Maurer in view of Costin*

Claims 1, 15-16, 23, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 4,507,346 to Maurer et al. (“Maurer”) in view of Costin. Applicants respectfully traverse.

Maurer discloses a multilayer identification card in which part of the information is in the form of a structure in relief in a foamable synthetic material. Maurer, Abstract. A laser may be used to activate chemical or physical blowing agents in the foamable synthetic material to induce a locally controllable foaming process. Maurer, Abstract.

With regard to independent claim 1, claim 1 is patentable over Maurer and Costin because these references fail to teach or suggest all of the features recited in claim 1. For

example, the June 9 Action concedes that “Maurer does not disclose that the relief structure is formed from cotton fibers [of] the [security] paper” as recited in claim 1. June 9 Action, page 5. As discussed above, Costin also fails to teach or suggest this feature. For at least this reason, claim 1 is patentable over any combination of Costin and Schell. Furthermore, claims 15-16 and 23 depend from claim 1 and incorporate all of the limitations recited therein and not disclosed by Maurer or Costin. For at least this reason, these claims are also patentable over the cited references. Accordingly, Applicants respectfully submit that the rejection of claim 1 and these dependent claims under 35 U.S.C. § 103(a) should be withdrawn.

With regard to claim 28, claim 28 is patentable over Maurer and Costin because these references fail to teach or suggest all of the features recited in claim 28. For example, neither references teaches or suggests “a relief structure that is formed from cotton fibers of the security paper” as recited in claim 24 and incorporated into claim 28 by its dependence on claim 24. As discussed with regard to claim 1, the June 9 Action concedes that “Maurer does not disclose that the relief structure is formed from cotton fibers in the paper,” and it has already been shown that Costin fails to teach or suggest this feature. For at least this reason, claim 28 is patentable over the cited references. Accordingly, Applicants respectfully submit that the rejection of claim 28 under 35 U.S.C. § 103(a) should be withdrawn.

*Maurer in view of Costin and Solmsdorf*

Claims 17-22 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maurer in view of Costin and in further view of U.S. Pat. No. 6,082,778 to Solmsdorf (“Solmsdorf”). Applicants respectfully traverse.

Solmsdorf discloses a copy protection element comprising a metallic layer that it etched by a laser to incorporate recognizable markings. Solmsdorf, Abstract. According to Solmsdorf, a photocopier will not detect light specularly reflected from the metallic layer. Solmsdorf, Col. 2 lines 11-15. Thus, the markings etched into the metal layer may be easily perceivable by a person but would not be accurately reproduced in a photocopy. Solmsdorf, Col. 2 lines 15-25.

Claims 17-22 and 29 are patentable over Maurer, Costin, and Solmsdorf because the references fail to teach or suggest all of the features recited therein. For example, as discussed

above, neither Maurer nor Costin teaches or suggests that “the relief structure is formed from cotton fibers of the security paper” as recited in claim 1 and incorporated into claims 17-22 by their dependence on claim 1. Solmsdorf, which is directed toward metallic security features, also fails to teach or suggest this feature, and the June 9 Action does not cite any portion of Solmsdorf as allegedly disclosing this feature. Similarly, none of the cited references teaches or suggests “a relief structure that is formed from cotton fibers of the security paper” as recited in claim 24 and incorporated into claim 28 by its dependence on claim 24. For at least this reason, claims 17-22 and 29 are patentable over any combination of these references. Accordingly, Applicants respectfully submit that the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance and should now be passed to issue.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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Date

  
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